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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,494	12/08/2000	Michael C. Morrison	STL9-2000-0071US1/1855P	2391

7590 08/26/2004

Joseph A. Sawyer, Jr.
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EXAMINER

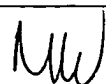
ABDI, KAMBIZ

ART UNIT PAPER NUMBER

3621

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/733,494	MORRISON, MICHAEL C.	
	Examiner	Art Unit	
	Kambiz Abdi	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-36, 41-46 and 51-56 is/are rejected.
- 7) ☒ Claim(s) 37-40, 47-50, and 57-60 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/9/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- Claims 1-30 are canceled.
- Claims 31-60 are added
- Claims 31-60 have been considered.

2. Examiner withdraws rejection of claims 1, 11, 21 under 35 U.S.C 112-second paragraphs due to cancellation of the claims and further explanation in view the specifications by the applicant.

3. Examiner withdraws rejection of claims 1, 11, 21 under 35 U.S.C 101 due to cancellation of the claims by the applicant.

Response to Arguments

4. Applicant's arguments filed 19 May 2004 have been fully considered but they are not persuasive for the following reasons:

5. Applicant's argument in regards to the claims 31, 41, and 51 states "If the value stored in the customer's computer system does not match a part of (emphasis added) the value stored in the server...". Examiner finds this not be the case at least with above claims and no such limitation has been recited in the independent claims 31, 41, and 51. Therefore, the argument put forward by the applicant is not persuasive at least for the above reason. Although, the applicant's arguments in regards to claims 37-40, 47-50 and 57-60 has been taken to be persuasive by the examiner.

Claim Objections

6. Claims 37-40, 47-50, and 57-60 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 31-35, 41-45, and 51-55 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,963,915 to Steven T. Kirsch or U.S Patent No. 6,311,269 to Gary L. Luckenbaugh et al.

9. As per claims 31, 41, and 51, Kirsch and Luckenbaugh clearly disclose, a method, system, and computer readable medium for conducting a transaction over a network, the network including a first system and a second system, the method, system, and program instructions comprising the steps of:

(a) receiving in the second computer system a request from a user of the first computer system to download data from the second computer system;

(b) determining by the second computer system whether the request represents a new transaction or an incomplete transaction by comparing a first value stored in the first computer system with a second value stored in the second system; and

(c) if the request represents an incomplete transaction, completing the transaction, wherein the user is not charged duplicate fees associated with starting a new transaction (See Kirsch abstract, figure3 and associated text, column 3, lines 4-32, column 4, lines 48-64, and column 13, lines 15-51 and Luckenbaugh figures 2, 2B, 2C, 3, and 4 and associated text, column 3, lines 35-64, column 5, lines 14-64, column 7, lines 9-63, and column 8, lines 1-13 and lines 53-65,. To clarify both Kirsch and Luckenbaugh systems establish communication between a client and a server to retrieve certain information from a server, once this communication is established the server checks the client for existence of a cookie if such cookie exist the server compares the cookie with existing cookies in the

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storage at the server. Once the cookie has been verified depending on the last transaction the cooki has been related to the transaction will continue.)

10. As per claims 32, 42, and 52, Kirsch and Luckenbaugh clearly disclose, all the limitations of claims 31, 41, and 51, further;

Kirsch and Luckenbaugh clearly disclose,

- the first system comprises a client system and the second system comprises a server system (See Kirsch abstract, figure3 and associated text, column 3, lines 4-32, column 4, lines 48-64, and column 13, lines 15-51 and Luckenbaugh figures 2, 2B, 2C, 3, and 4 and associated text, column 3, lines 35-64, column 5, lines 14-64, column 7, lines 9-63, and column 8, lines 1-13 and lines 53-65).

11. As per claims 33, 43, and 53, Kirsch and Luckenbaugh clearly disclose, all the limitations of claims 31, 41, and 51, further;

Kirsch and Luckenbaugh clearly disclose,

- the first value of the client system is stored in a persistent client-side data file (See Kirsch abstract, figure3 and associated text, column 3, lines 4-32, column 4, lines 48-64, and column 13, lines 15-51 and Luckenbaugh figures 2, 2B, 2C, 3, and 4 and associated text, column 3, lines 35-64, column 5, lines 14-64, column 7, lines 9-63, and column 8, lines 1-13 and lines 53-65).

12. As per claims 34, 44, and 54, Kirsch and Luckenbaugh clearly disclose, all the limitations of claims 31, 41, and 51, further;

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Kirsch and Luckenbaugh clearly disclose,

- the persistent client-side data file comprises a cookie (See Kirsch abstract, figure3 and associated text, column 3, lines 4-32, column 4, lines 48-64, and column 13, lines 15-51 and Luckenbaugh figures 2, 2B, 2C, 3, and 4 and associated text, column 3, lines 35-64, column 5, lines 14-64, column 7, lines 9-63, and column 8, lines 1-13 and lines 53-65).

13. As per claims 35, 45, and 55, Kirsch clearly discloses all the limitations of claims 31, 41, and 51, further;

Kirsch and Luckenbaugh clearly disclose,

- b1) allowing the server system to compare the first value in the cookie with the second value in the server system (See Kirsch abstract, figure3 and associated text, column 3, lines 4-32, column 4, lines 48-64, and column 13, lines 15-51 and Luckenbaugh figures 2, 2B, 2C, 3, and 4 and associated text, column 3, lines 35-64, column 5, lines 14-64, column 7, lines 9-63, and column 8, lines 1-13 and lines 53-65).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 36, 46, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,963,915 to Steven T. Kirsch or U.S Patent No. 6,311,269 to Gary L. Luckenbaugh et al. as applied to claims above, and further in view of U.S. Patent No. 5,991,399 to Gary L. Grauke et al.

16. As per claims 36, 46 , and 56, Kirsch and Luckenbaugh disclose all the limitations of claims 31, 41, and 51, further;

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But they do not teach the following, however, Grauke clearly teaches,

- d) if the request represents a new transaction, generating a new encryption key by the second system, wherein the new encryption key is associated with the new transaction;
- e) storing a first portion of the new encryption key in the first computer system as the first value; and
- f) storing the whole new encryption key on the second computer system as the second value. (See Grauke abstract, figures 2, 4A and 4B and associated text, column 3, lines 5-20 and 60-68, column 6, lines 17-35, column 7, lines 8-68, and column 8, lines 1-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kirsch and Luckenbaugh and Grauke to achieve a greatly increased protection and control of downloads of data files by encrypting them and tracking the download process.

17. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

19. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington D.C. 20231**

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

Abdi/K

August 23, 2004



**JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**